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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/907,906      | 07/19/2001  | Hideki Akiyama       | 24709               | 9941             |

20529 7590 06/28/2005

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EXAMINER

ROBINSON, MYLES D

ART UNIT PAPER NUMBER

2622

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |                |  |
|------------------------------|-------------------|----------------|--|
| <b>Office Action Summary</b> | Application No.   | Applicant(s)   |  |
|                              | 09/907,906        | AKIYAMA ET AL. |  |
|                              | Examiner          | Art Unit       |  |
|                              | Myles D. Robinson | 2622           |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/24/2003</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The examiner has considered the references listed in the Information Disclosure Statement (IDS) submitted on 7/24/2003 (see attached PTO-1449).

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: reference 31 in Figure 6, reference 4 in Figure 8, and reference S6 in Figure 13. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The abstract of the disclosure is objected to because of a misspelling. It is suggested that the word "messa0ge" in line 7 be replaced with "message". The Correction is required. See MPEP § 608.01(b).
5. Furthermore, the disclosure is objected to because of the following informalities:  
There is no detailed discussion of Figure 9 within the disclosure.  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. ***Claims 1 – 18, 20, and 21*** are rejected under 35 U.S.C. 102(b) as being anticipated by **Reed et al.** (U.S. Patent No. 5,130,806).

Referring to **claim 1**, Reed et al. disclose a data transferring apparatus for transmitting print data to be printed by a printing machine (see Fig. 1, printing system 2) connected thereto through a communication line (column 5, lines 14 – 17, column 8, lines 35 – 56) comprising operation inputting section (column 5, lines 35 – 46) for making message information (column 7, lines 33 – 48 and column 8, lines 26 – 32) added to the print data including image data and print information concerning the image data in response to an operation by a user (see Fig. 8, step 200, column 6, line 60 – column 7, line 48), print-data making section for making message-added print data by adding the message information made by the operation inputting section to the print data (column 5, lines 35 – 46), transmitting section for transmitting the message added-print data made by the print-data making section through the communication line (see Figs. 5B and 14, RS232 serial communications port 53, column 8, lines 35 – 48).

Referring to **claim 2**, Reed et al. disclose the apparatus further wherein the print-data making section converts the print data into a format processible by the printing machine (see Fig. 5A, image generator processors 86 and column 5, lines 12 – 14, 63 – 66).

Referring to **claim 3**, Reed et al. disclose the apparatus further wherein the print-data making section executes an application program for processing print data to make the message-added print data (column 5, lines 35 – 62).

Referring to **claim 4 – 6**, the rationale provided in rejection of claims 1 – 3, respectively, is incorporated herein. In addition, the apparatus of claims 1 – 3 perform the method of claims 4 – 6, respectively.

Referring to **claim 7**, Reed et al. disclose a printing machine comprising printing section for performing printing (see Fig. 2, printing section 8 and column 4, lines 29 – 33), receiving section for receiving message-added print data obtained by adding message information (column 7, lines 33 – 48 and column 8, lines 26 – 32) made by a data transmitting instrument (printing system 2) to print data transmitted from the data transmitting instrument, the print data including image data to be printed by the printing section and print information concerning the print data (see Fig. 7, job ticket 150), the receiving section being connected to the data transmitting instrument through a communication line (see Fig. 5B, RS232 serial communications port 53, column 5, lines 14 – 17 and column 8, lines 35 – 48), displaying section for displaying the message information included in the message-added print data received by the receiving section (see Fig. 8, step 212, Fig. 9, step 304, and column 6, line 60 – column 7, line 48), controlling section for performing control to take the message information concerning the image data out of the print data received by the receiving section and to display the contents on the displaying section (see Fig. 8, steps 212, 218 and 220, Fig. 9, steps 300, 304 and 306, column 5, lines 35 – 46, column 6, lines 25 – 31, column 7, lines 2 – 17, 22 – 24 and column 8, lines 26 – 32).

Referring to **claim 8**, Reed et al. disclose the machine further wherein the controlling section controls the displaying section to display print information (see Fig. 7, job ticket 150 and column 6, lines 25 – 31) included in the print data together with the message information (see Fig. 11, touchscreen 62 and column 8, lines 26 – 32).

Referring to **claim 9**, Reed et al. disclose the machine further wherein the data transmitting instrument is composed of a printer driver corresponding to the printing section (see Fig. 5A, dispatch processors 88 and 89, column 5, lines 14 – 17, 66 – 67).

Referring to **claim 10 – 12**, the rationale provided in rejection of claims 7 – 9, respectively, is incorporated herein. In addition, the apparatus of claims 7 – 9 perform the method of claims 10 – 12, respectively.

Referring to **claim 13**, Reed et al. disclose a printing machine comprising printing section for performing printing (see Fig. 2, printing section 8 and column 4, lines 29 – 33), receiving section for receiving message-added print data obtained by adding message information (column 7, lines 33 – 48 and column 8, lines 26 – 32) made by a data transmitting instrument (printing system 2) to print data transmitted from the data transmitting instrument, the print data including image data to be printed by the printing section and print information concerning the print data (see Fig. 7, job ticket 150), the receiving section being connected to the data transmitting instrument through a communication line (see Figs. 5B and 14, RS232 serial communications port 53, column 8, lines 35 – 48), displaying section for displaying the message information included in the message-added print data received by the receiving section (see Fig. 8, step 212, Fig. 9, step 304, and column 6, line 60 – column 7, line 48), controlling section for performing control to take the message information concerning the image data out of the print data received by the receiving section and to print contents of the message information and of the image data by the printing section (see Fig. 8, steps 212, 218 and

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220, Fig. 9, steps 300, 304 and 306, column 5, lines 35 – 46, column 6, lines 25 – 31, column 7, lines 2 – 17, 22 – 24 and column 8, lines 26 – 32).

Referring to **claim 14**, Reed et al. disclose the machine further wherein the controlling section controls the printing section to print the print information included in the print data together with the message information (see Fig. 9 and column 7, lines 33 – 48).

Referring to **claim 15**, Reed et al. disclose the machine further wherein the data transmitting instrument is composed of a printer driver corresponding to the printing section (see Fig. 5A, dispatch processors 88 and 89, column 5, lines 14 – 17, 66 – 67).

Referring to **claim 16 – 18**, the rationale provided in rejection of claims 13 – 15, respectively, is incorporated herein. In addition, the apparatus of claims 13 – 15 perform the method of claims 16 – 18, respectively.

Referring to **claim 20**, Reed et al. disclose a printing system comprising a data transmitting apparatus for transmitting message-added print data obtained by adding message information (column 7, lines 33 – 48 and column 8, lines 26 – 32) to print data including image data and print information concerning the image data and a printing machine including: printing section for performing printing (see Fig. 2, printing section 8 and column 4, lines 29 – 33); receiving section for receiving the message-added print data, the receiving section being connected to the data transmitting apparatus through a communication line (column 5, lines 14 – 17, column 8, lines 35 – 56); displaying section for displaying the message information included in the message-added print data received by the receiving section (see Fig. 8, step 212, Fig. 9, step 304, and



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column 6, line 60 – column 7, line 48); controlling section for performing control to take the message information concerning the image data out of the print data received by the receiving section and to display contents of the message information on the displaying section (see Fig. 8, steps 212, 218 and 220, Fig. 9, steps 300, 304 and 306, column 5, lines 35 – 46, column 6, lines 25 – 31, column 7, lines 2 – 17, 22 – 24 and column 8, lines 26 – 32).

Referring to **claim 21**, Reed et al. disclose a printing system comprising a data transmitting apparatus for transmitting message-added print data obtained by adding message information (column 7, lines 33 – 48 and column 8, lines 26 – 32) to print data including image data and print information concerning the image data and a printing machine including: printing section for performing printing (see Fig. 2, printing section 8 and column 4, lines 29 – 33); receiving section for receiving the message-added print data, the receiving section being connected to the data transmitting apparatus through a communication line (column 5, lines 14 – 17, column 8, lines 35 – 56); displaying section for displaying the message information included in the message-added print data received by the receiving section (see Fig. 8, step 212, Fig. 9, step 304, and column 6, line 60 – column 7, line 48); controlling section for performing control to take the message information concerning the image data out of the print data received by the receiving section and to print contents of message information and of the image data by the printing section (see Fig. 8, steps 212, 218 and 220, Fig. 9, steps 300, 304 and 306, column 5, lines 35 – 46, column 6, lines 25 – 31, column 7, lines 2 – 17, 22 – 24 and column 8, lines 26 – 32).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. ***Claim 19*** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Reed et al.** (U.S. Patent No. 5,130,806) in view of **Mensing et al.** (U.S. Patent No. 5,266,112).

Referring to **claim 19**, Reed et al. disclose a printing system for printing data by a printing machine, the print data being transmitted from a data transferring apparatus to be printed by the printing machine connected thereto through a communication line (column 5, lines 14 – 17, column 8, lines 35 – 56) comprising a data transferring apparatus including: operation inputting section (column 5, lines 35 – 46) for making message information (column 7, lines 33 – 48 and column 8, lines 26 – 32) to be added to the print data including image data and print information concerning the image data in response to an operation by a user (see Fig. 8, step 200, column 6, line 60 – column 7, line 48); print-data making section for making message-added print data by adding the message information made by the operation inputting section to the print data (column 5, lines 35 – 46); and transmitting section for transmitting the message-added print data made by the print-data making section to a printing controlling apparatus connected to the printing machine through the communication line (see Figs. 5B and 14, RS232 serial communications port 53, column 8, lines 35 – 48) and the printing machine (see Fig. 1,

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printing system 2) for performing printing by use of the image data transmitted from the printing controlling apparatus but does not explicitly disclose the printing controlling apparatus for receiving the message-added print data transmitted from the transmitting section and for outputting at least the image data to the printing machine.

Mensing et al. disclose the printing controlling apparatus (see Fig. 1, server 25 and column 3, lines 38 – 41) for receiving the message-added print data transmitted from the transmitting section (column 4, lines 34 – 37) and for outputting at least the image data to the printing machine (column 3, lines 46 – 53, 60 – 67 and column 4, lines 17 – 19, 28 – 37).

Reed et al. and Mensing et al. are combinable because they are both from the same field of endeavor, being transmitting print jobs to printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include the printing controlling apparatus taught by Mensing et al. within the printing system taught by Reed et al. The suggestion/motivation for doing so would have been to gain advantages such as increased user access to multiple shared network resources, the elimination of print driver/server PDL compatibility problems, and more efficient data processing, as suggested by Mensing et al. (column 1, line 31 – column 2, line 42).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Lockhart et al.** (U.S. Patent No. 6,732,152 B2) disclose methods and apparatus for generation and distribution of surface mail objects.

**Maxwell** (U.S. Patent No. 5,805,810) discloses an apparatus and methods for converting an electronic mail to a postal mail at the receiving station.

**Lepetit et al.** (U.S. Patent No. 5,652,794) disclose a device and process for securizing a document and graphic authentication code.

**Maniwa et al.** (U.S. Patent No. 5,768,483) disclose a method of reporting result of execution of print job in network system, method of setting scanning conditions in network system, and network printing/scanning system.

**Bellucco et al.** (U.S. Patent No. 5,524,085) disclose multimedia job tickets for printing machines.

**Yanai et al.** (U.S. Patent No. 5,666,210) disclose a document communication apparatus and document communication system.

**Berson** (U.S. Patent No. 5,426,700) discloses a method and apparatus for verification of classes of documents.

**Hube** (U.S. Patent No. 5,436,730) discloses a method of managing a proof approval process for proofing documents in a printing system.

**Krist et al.** (U.S. Patent No. 5,615,015) disclose an apparatus and method of programming a job to be processed at a location other than the location at which the job is prepared.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MDR



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